REMARKS

Applicant appreciates the time taken by the Examiner to review Applicant's present application. Applicant has amended Claims 5 and 16 and added Claims 24 and 25. Applicant respectfully submits that no new matter has been added. Accordingly, Claims 1-25 remain pending in this application. This application has been carefully reviewed in light of the Official Action mailed October 21, 2005. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 112

Claims 5-7 and 16-18 stand rejected under 35 U.S.C. § 112, second paragraph.

Applicant has amended Claims 5 and 16. Applicant respectfully submits that no new matter has been added by these amendments, and that these amendments render the above rejection moot. Accordingly, Applicant respectfully requests the Examiner withdraw the rejection.

Rejections under 35 U.S.C. § 102

Claims 1-4, 8-15 and 19-23 stand rejected as anticipated by U.S. Patent No. 6,859,909 ("Lerner"). Applicant respectfully traverses this rejection.

Claims 1, 12 and 23

Claim 1 recites a method of modifying a target document comprising accessing a target document, a metadata element, and a rendering instruction, wherein the target document comprises a target element, locating the target element to which the metadata element applies, transforming the metadata element into a rendered element by using the rendering instruction and displaying the rendered element in conjunction with the target element. Claims 12 and 23 recite similar limitations.

Thus, embodiments of the invention allow metadata elements and target elements of a target document to be displayed in the same rendered document displayed by a browser. In certain embodiments this may be accomplished by accessing a target document which comprises a set of target elements, a metadata document comprising a set of metadata

elements which apply or describe certain types of target elements, and a set of rendering instructions which describe how a particular type of metadata element should be turned into, or transformed into, a rendered element.

For each of the metadata elements in the metadata document it is determined whether a matching target element can be found in the target document. In certain embodiments, to make these determinations the target document must be parsed to obtain the target elements. If a matching target element is found for a metadata element, a rendering instruction which applies to the metadata element is used to produce a rendered element from the metadata element.

This rendered element can then be displayed in conjunction with the target element. In one embodiment, this may be accomplished by inserting the rendered element into the rendered target document during rendering of the target document, or subsequently thereto. Thus, in embodiments of the invention, the rendered element and the target element are displayed in a single rendered document.

The Lerner reference, in direct contrast, "overlays an active image file onto the WBD [web based document] to simulate drawing directly into the browser." (*See*, Lerner Summary of the Invention, Lines 45-48, Col. 8, Lines 41-44). More particularly, the annotation software of Lerner allows a user to annotate a rendered web page by inserting on top of that rendered web page a transparent image file that contains the annotations. To allow a user to interact with the rendered web page the annotation software may allow browser events to pass through the annotation image file so that a user has complete access to the underlying rendered web page. (*See*, Lerner, Col. 7, Lines 3-9)

To allow a user to create an annotated web page, the annotation software of Lerner creates an annotation record to capture information about a user's annotations and then overlays a blank image file on top of a rendered web page. Annotation software then waits for the user to add an annotation event. The technical annotation information is then appended to the annotation record by appending the annotation image to an image file. (*See*, Lerner Col. 8, Line 45-Col.9, Line 5) This image file is then overlaid on top of the rendered web page to create an annotated web page. (*See*, Lerner Col. 10, Lines 27-30) Thus, an annotation record contains pertinent information relating to the appearance or make-up of a single annotated web page by storing information related to the original (unannotated) web page and an image file containing the annotations. (*See* Lerner Col 4, Lines 65-Col. 5, Lines 9) Furthermore, this

means that an annotation record does not contain information pertaining to individual annotations, but instead the annotation record contains an image file which contains all the annotations. (*See*, Lerner Col.7, Lines 3-8)

Since, when displaying an annotated web page, the image file created by the annotation software overlays the prior top most layer of the original unannotated web page it blocks input device events. Thus, to allow input events to pass through to the original unannotated web page Lerner must "burn a hole" in the image file around an input device so that input events can find their way to the original unaltered web page below the image file. (*See,* Lerner Col. 10, Lines 37-48)

The Examiner states that Lerner discloses a method of modifying a target document. First and foremost Applicant respectfully disagrees with this assessment. As Lerner overlays an active image file containing annotations on an unaltered web page, Lerner does not modify a target document.

Furthermore, as Lerner employs a single annotation record for an annotated web page, where the annotation record contains a reference to the unaltered web page and an active image file which contains all the actual graphical images comprising all the annotations, Lerner does not disclose a metadata element (which may describe a type of target element) or a rendering instruction (which may describe how a metadata element is supposed to be transformed or rendered into a rendered element). (*See*, Lerner Col. 5, Lines 1-9)

While the Examiner asserts that rendering instructions for the metadata elements are stored in the image file containing the appearance of the metadata, the Applicant respectfully disagrees. The image file contains the graphical image which correspond to all the annotations for an annotated web page. Thus, nothing in the image file describes how metadata, or anything else, is supposed to transformed or rendered. Instead the image file contains the actual image that will be overlaid on an unaltered web page in order to annotate that web page. (*See*, Lerner Col. 10, Lines 42-45) As Lerner does not disclose metadata elements (which may describe a type of target element) or rendering instructions (which may describe how a metadata element is supposed to be transformed or rendered), Lerner does not disclose accessing a target document, a metadata element and a rendering instruction, wherein the target document comprises a target element as recited in Claim 1.

Additionally, Lerner does not disclose locating a target element (which is within a target document) to which the metadata element applies. As mentioned above, Lerner does not

disclose metadata elements. The Examiner asserts that an annotation record maintains a pointer to the target element that an annotation modifies. However, an annotation record stores the file location of the original unannotated web page. (*See*, Lerner Col. 7, Lines 23-26) Thus, the annotation record stores the file location of the unannotated web page (which may be equated with a target document) not elements within that unannotated web page. Consequently, because Lerner does not disclose metadata elements and never locates a target element to which the metadata element applies, Lerner does not disclose locating the target element to which the metadata element applies, as recited in Claim 1.

Moreover, as Lerner does not disclose a metadata element or a rendering instruction, and as Lerner renders an annotated web page by rendering the unaltered web page and overlaying an image file containing all the annotations over the unannotated web page, Lerner does not disclose transforming the metadata element into a rendered element using a rendered instruction, as recited by Claim 1.

Accordingly, as Lerner does not disclose all the limitations of Claim 1, Applicant respectfully submits that Lerner does not anticipate Claim 1, and respectfully requests the withdrawal of the rejection of Claim 1. As Claims 12 and 23 recite limitations similar to those in Claim 1, Applicant respectfully requests the withdrawal of the rejection of Claims 12 and 23 as well.

Claim 8 and 19

Claims 8 and 19 are dependent on Claims 1 and 12 respectively, and recite the further limitation of inserting the rendered element into the target document. As discussed above Lerner discloses that an image file is overlaid on top of the rendered web page to create an annotated web page. (*See*, Lerner Col. 10, Lines 27-30) As Lerner discloses overlaying an unaltered web page with an image file, Lerner does not disclose inserting the rendered element into the target document as recited by Claims 8 and 19. Accordingly, Applicant respectfully requests the withdrawal of the rejection of Claims8 and 19.

Claims 2-4, 9-15 and 20-22

As Claims 2-4, 9-15 and 20-22 depend directly or indirectly on Claims 1 or 12, Applicant respectfully submits that the above arguments apply equally well with respect to Claims 2-4, 9-15 and 20-22 and respectfully requests the withdrawal of the rejection of these claims.

Rejections under 35 U.S.C. § 103

Claims 5-7 and 16-18 stand rejected as obvious over U.S. Patent No. 6,859,909 ("Lerner"). As Claims 5-7 and 16-18 are dependent on Claims 1 or 12, Applicant respectfully submits that the above arguments apply equally well to Claims 5-7 and 16-18. Accordingly, withdrawal of this rejection is respectfully requested.

Newly Added Claim 24 and 25

Applicant has added Claims 24 and 25 to more distinctly point out and claim the present invention, support for which can be found in the specification at least in paragraphs [0023]-[0034]. Accordingly, Applicant respectfully requests allowance of these claims.
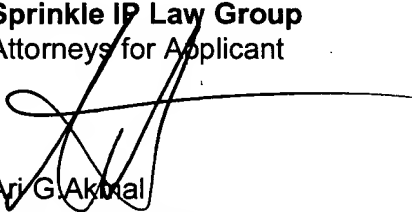
CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for allowance. Other than as explicitly set forth above, this reply does not include an acquiescence to statements, assertions, assumptions, conclusions, or any combination thereof in the Office Action. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests full allowance of Claims 1-25. The Examiner is invited to telephone the undersigned at the number listed below for prompt action in the event any issues remain.

The Director of the U.S. Patent and Trademark Office is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 50-3183 of Sprinkle IP Law Group.

Respectfully submitted,

Sprinkle IP Law Group
Attorneys for Applicant

Ari G. Akmal
Reg. No. 51,388

Date: January 19, 2006

1301 W. 25th Street, Suite 408
Austin, TX 78705
Tel. (512) 637-9226
Fax. (512) 371-9088